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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,384	02/10/2004	Steven W. Meyer	09777-00002	9906
21918	7590	04/04/2006	EXAMINER	
DOWNS RACHLIN MARTIN PLLC 199 MAIN STREET P O BOX 190 BURLINGTON, VT 05402-0190			CHIU, RALEIGH W	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/775,384	Applicant(s) MEYER.ET AL.	
	Examiner Raleigh Chiu	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
4a) Of the above claim(s) 18, 19, 23, 24, 27-46 and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 22 is/are rejected.
- 7) ☒ Claim(s) 20, 21, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Applicant's election of invention I in the reply filed on 27 January 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Further, claims 1-17, 20-22, 25 and 26 are considered to correspond to Group I. In the election requirement in the Office action mailed 28 December 2005, claims 18 and 19 were inadvertently included within Group I; however, claims 18 and 19 were withdrawn from further consideration as a result from applicant's election on 10 October 2005.

Therefore, claims 1-17, 20-22, 25 and 26 are being considered here.

2. Claims 47, 48, 50 and 51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10 October 2005.

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Claim Rejections - 35 USC §§ 102 and 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

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U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-5, 9, 13, 14, 16, 17, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 4,158,342 (Scruggs).

Regarding claims 1, 2, 4, 5 and 9, Figures 1-3 of Scruggs show an elongate resilient flexible member 4 with spaced-apart indicia 20. Scoring marker 22 corresponds to the recited movable spotter.

Regarding claim 3, the Scruggs wristband is considered to be inherently capable of being used with spotting a plurality of items.

Regarding claim 13, scoring marker 22 is considered to be an identifier.

Regarding claim 14, scoring marker 22 is considered to be inherently capable of being used as a travel destination identifier.

Regarding claims 16 and 17, Figure 1 shows complementary hook and loop connectors at the ends 16,18.

Regarding claim 22, the Scruggs indicia is considered to be inherently capable of being used to correspond to other items.

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7. Claims 1, 3-5, 9-11, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 4,132,187 (Moebius).

Regarding claims 1, 3-6 and 9, Figure 1 of Moebius shows a device made from a thin metal plate. See column 2, lines 49-51. A thin metal is considered to have a certain degree of resiliency and flexibility. Figure 1 further shows indicia and a slidable spotter 142.

Regarding claim 7, the geometry of spotter 142 prohibits it from rotating.

Regarding claims 10 and 11, spotter 142 is a magnifying lens. See column 3, lines 27-34.

8. Claims 1, 3-5, 9-11, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,023,956 (Fox).

Regarding claim 1, Figure 1 of Fox shows an elongate resilient flexible member 11 with indicia 14. Loop 32 corresponds to the recited movable spotter and is inherently capable of indicating selected indicia.

Regarding claim 8, it is well-known to squeeze or compress loop 32 to move it along the flexible member 11.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scruggs as applied above.

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Regarding claim 15, it would have been an obvious matter of design choice to make the Scruggs spotter shaped like a tennis player, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art.

10. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moebius as applied above.

Regarding claim 12, it would have been obvious to one of ordinary skill in the art to provide an illuminator with the Moebius device to allow a player to keep score in low-light conditions.

Regarding claim 15, it would have been an obvious matter of design choice to make the Moebius spotter shaped like a tennis player, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art.

Allowable Subject Matter

11. Claims 20, 21, 25 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten

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in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

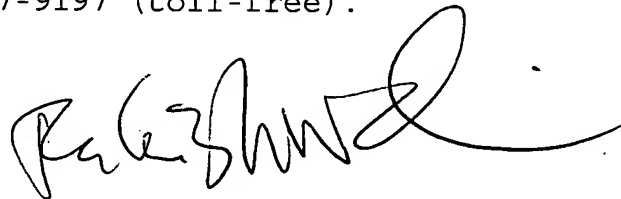
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on (571) 272-4463.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu
Primary Examiner
Technology Center 3700